REMARKS

This is in response to the *Advisory* Office Action, dated November 30, 2005, where the Examiner has rejected claims 24-35 and 37-41. By the present amendment, applicant has amended claims 24, 27 and 29 to cure a minor informality and/or clerical mistake. After the present amendment, claims 24-35 and 37-41 are pending in the present application. Allowance of pending claims 24-35 and 37-41 in view of the amendments and the following remarks is respectfully requested.

A. Rejection of Claim 24-32 and 37-41 under 35 U.S.C. § 103(a)

The Examiner has rejected claim 24-32 and 37-41 under 35 U.S.C. § 103(a), as being unpatentable over Plotnik (USPN 6,873,608) ("Plotnik") in view of Thompson. Applicant respectfully disagrees.

Applicant hereby swears behind the effective filing date of Thompson, i.e. March 29, 1999, under 37 C.F.R. § 1.131. Under 37 C.F.R. § 1.131, the owner of the claimed invention may submit an appropriate declaration to overcome a reference. The showing of facts shall be such as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the effective date of the reference to a subsequent reduction to practice or to the filing of the application. See 37 C.F.R. § 1.131. Applicant respectfully submits that claims 24-32 and 37-41 are allowable over Plotnik in view of Thompson based on the following remarks.

Pursuant to 37 C.F.R. § 1.131, attached is a declaration from Mark V.B. Tremallo, General Counsel, Vice President and Secretary of Skyworks Solutions, Inc., which is the owner

of the above-referenced patent application, including a copy of an Innovation Disclosure. (Decl. ¶ 1.) The Innovation Disclosure describes the invention of the above-described patent application in Docket No. 99RSS133, entitled "Universal Cell Phone to USB Adapter", which was entered into the Innovation Disclosure Database, on February 12, 1999. (Decl. ¶ 3.)

The Examiner will note that the last page of the enclosed Innovation Disclosure clearly shows that the Innovation Disclosure was entered into the Innovation Disclosure Database, on February 12, 1999, which predates the effective filing date of Thompson, i.e. March 29, 1999. Applicant respectfully submits that the Innovation Disclosure evidences that the inventors conceived and were in possession of the presently claimed subject matter on February 12, 1999.

Further, the Innovation Disclosure and also the filing of the parent of the above-referenced patent application in the USPTO, on May 13, 1999, evidence that the invention of the above-referenced application was reduced to practice in the United States using due diligence after conception. (Decl. ¶ 4.)

Accordingly, applicant respectfully requests that the rejection of claims 24-32 and 37-41, as being unpatentable over Plotnik in view of Thompson, under 35 U.S.C. § 103(a), be withdrawn.

B. <u>Rejection of Claims 33-35 under 35 U.S.C. § 103(a)</u>

The Examiner has rejected claims 33-35 under 35 U.S.C. § 103(a), as being unpatentable over Plotnik in view of Thompson, and further in view of Colson (USPN 6,574,734) ("Colson").

Applicant respectfully submits that claims 33-35 depend from claim 32, and should be allowed at least for the same reasons stated above in conjunction with patentability of claim 32.

C. **Properness of Declaration under 37 C.F.R. § 1.131**

In the Advisory Action of November 30, 2005, the Examiner states that applicant's declaration under 37 C.F.R. § 1.131 is not proper, because Thompson claims the same invention as claimed by the pending claims of the present application. Applicant respectfully disagrees.

First, applicant respectfully submits that Thompson does not claim the same invention as that claimed by the pending claims of the present application. In In re Zletz, 893 F.2d 319 (Fed. Cir. 1989), the Federal Circuit has provided the following instructions:

> Rule 131 provides an ex parte mechanism whereby a patent applicant may antedate subject matter in a reference, even if the reference describes the same invention that is claimed by the applicant, provided that the same invention is not claimed in the reference when the reference is a United States patent. As explained in In re McKellin, 529 F.2d 1324, 1329, 188 U.S.P.Q. (BNA) 428, 434 (CCPA 1976), **the disclosure in a reference United States patent does not fall under 35 U.S.C. § 102(g) but under 35 U.S.C. § 102(e), and thus can be antedated in accordance with Rule 131**. But when the subject matter sought to be antedated is claimed in the reference patent, Rule 131 is not available and an interference must be had to determine priority. In re Eickmeyer, 602 F.2d 974, 979, 202 U.S.P.Q. (BNA) 655, 660 (CCPA 1979); In re Clark, 59 C.C.P.A. 924, 457 F.2d 1004, 1007, 173 U.S.P.Q. (BNA) 359, 361 (1972). (emphasis added.)

Applicant respectfully submits that claims of Thompson do not include the same limitations as the pending claims in the present application. The Examiner has rejected the claims of the present application by citing the detailed specification of Thompson.[1] (See, Page 3 of the Final Office Action, which cites columns 4-6 and Fig.1 of Thompson.) Furthermore, the Examiner relies on Plotnik (not Thompson) to show the following elements of claim 24 (same with other independent claims):

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[1] Applicant further notes that MPEP 715.05 states that "if the reference is claiming the same invention as the application ..., this fact should be noted in the Office action." To the contrary, however, in the Final Office Action, the Examiner has rejected the claims by combining two more references, under Section 103(a), and did not state that Thompson's claims claim the same invention as the pending claims of the present application.

code for formatting said data in accordance with said communication protocol to generate formatted data; and
code for transmitting said formatted data over said cable.

Further, the Examiner has rejected the additional limitations of dependent claims 24-31, 33-35, 37-38 and 40-41 based on Plotnik (not Thompson.) Therefore, as admitted by the Examiner, not only Thompson's claims do not claim the same invention as claimed by the pending claims of the present application, but also Thompson's specification lacks certain subject matter claimed by the pending claims of the present application. This also confirms applicant's position that Thompson does not claim the same invention, because Thompson could not claim the same invention when its specification lacks support for the limitations recited in the pending claims of the present application.

As stated by the Federal Circuit, when claims are rejected based on the disclosure of a U.S. patent, the rejection does not fall under Section 102(g), but it falls under Section 102(e), and a declaration to swear behind the reference is effective. See, In re Zletz. Accordingly, applicant respectfully submits that claims 24-35 and 37-41 should be allowed.

D. Conclusion

For all the foregoing reasons, an early notice of allowance for claims 24-35 and 37-41 pending in the present application is respectfully requested. The Examiner is invited to contact the undersigned for any questions.

Respectfully Submitted;
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